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In re Application of  
Roderick Thompson  
Application No. 09/014,518  
Filed: January 28, 1998  
For: PREPARATION AND TRANSFER SHEET

:  
: DECISION DISMISSING  
: PETITION TO INSTITUTE  
: PUBLIC USE PROCEEDINGS  
:

This is a decision on the petition filed May 29, 1998, requesting that public use proceedings be instituted in the above-identified reissue application.

#### BACKGROUND

The present application is a merged reissue application and reexamination proceeding of U.S. Patent No. 5,472,790, issued on December 5, 1995, and assigned to New Age Products, Inc. (New Age).

On May 29, 1998, Progressive International Corporation filed the petition requesting the Commissioner to institute public use proceedings against the claims of the above-identified reissue application. The petition was accompanied by proof of service, the fee required by 37 CFR 1.17(j), and declarations of William Fishman, John Stoneman, John R. Benefiel, Freling Baker and Bruce K. Sauer and various exhibits (Paper No. 14).

On June 10, 1998, Petitioner filed a "Supplement To Public Use Petition" accompanied by a further declaration of John R. Benefiel and an exhibit (Paper No. 15).

conclusion is to be drawn as to novelty and unobviousness of the claimed invention in view of the admitted prior art.

MPEP 720.04 states in part that:

In all public use proceedings, whether the ultimate issue is anticipation under 35 U.S.C. 102 or obviousness over 35 U.S.C. 103, testimony will be limited to the issues of public use or on sale. No testimony will be received on whether the claimed subject matter would have been obvious over subject matter asserted to be in public use or on sale.

As indicated by the MPEP, the policy of the Office is to limit testimony to the facts establishing what was in "public use or on sale" and to the facts establishing when and where the "public use or on sale" occurred. Verified statements by third parties expressing their opinions concerning the lack of novelty and obviousness of an invention claimed in a pending application in view of established prior art may be presented by way of a protest under 37 CFR 1.291. See MPEP 1901.02. A public use proceeding is clearly unnecessary for that purpose.

Since the applicant has admitted that the "CounterMaid" mat is prior art, there is no need to institute public use proceedings in this particular case. The petition is moot and is hereby dismissed.

The application is being returned to the examiner in Examining Group 1770, via the Group Director, for further examination in due course. The examiner will, of course, consider the "public use or on sale" admissions made by the reissue applicant during further examination of the application.

Telephone inquiries specific to this matter should be directed to Senior Legal Advisor John F. Gonzales at (703) 305-9282.



Charles Pearson  
Patent Legal Administrator  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects

JFG

On July 22, 1998, Petitioner filed a "Second Supplement To Petition For Public Use Proceedings" accompanied by a declaration of David Phaller and an exhibit (Paper No. 16).

On August 13, 1998, New Age filed a reply to the petition and to the supplements thereto filed on June 10 and July 22, 1998. In its reply, New Age acknowledges that the "CounterMaid" mat referred to in the Fishman declaration filed on May 29, 1998, was sold or offered for sale to an extent that it qualifies as prior art. New Age also does not challenge the results of tests conducted by OCM Laboratories referred to in the Benefiel and Sauer declarations filed on May 29, 1998. Further, New Age acknowledges that it purchased a quantity of polypropylene sheets 0.022 inches in thickness from Socopac Co. more than one year prior to June 13, 1994 filing date of application No. 08/259,006 (the application which issued as U.S. Patent No. 5,472,790).

New Age argues in its reply that the purpose of a public use proceeding is to establish through testimony the truth of the facts asserted by a petitioner and, that in this case, New Age does not challenge the authenticity of the evidence supporting the asserted facts. Therefore, New Age argues that a public use proceeding is unnecessary.

#### DECISION

It is well established that evidence presented to the Patent and Trademark Office (Office) by a third party may not be used by the Office to reject an application, unless the applicant is given a fair opportunity to cross-examine the third party's witnesses and to present rebuttal evidence. Ex Parte von Heffner-Alteneck, 1883 C.D. 139 (Sup. Ct. D.C. 1882). Thus, where an applicant denies an allegation regarding a public use or sale of the claimed invention, a public use proceeding provides a procedure by which a third party may present factual evidence to the Office which the Office may use to establish that subject matter claimed in a pending application was in public use or on sale in this country more than one year prior to the effective U.S. filing date of the pending application. The institution of public use proceedings is discretionary with the Commissioner.

In this case, the reissue applicant is not denying the allegations regarding "public use or on sale" activity presented in the petition. In fact, the "public use or on sale" activity alleged in the petition has already been established by virtue of the admissions made by the reissue applicant in its opposition to the petition. Thus, the issues left to be decided relate to what